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10/692,017

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Vikram Madan

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BANNER & WITCOFF

1001 G STREET N W

SUITE 1100

WASHINGTON, DC 20001

EXAMINER

NGUYEN, CHAU T

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/692,017

Applicant(s)

MADAN ET AL.

Examiner

Chau Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 32-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 32-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>05/04/04 & 03/16/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Response to Election/Restriction, received on 03/15/2006, has been entered. Claims 1-25 and 32-43 are pending.

Election/Restrictions

2. Claims 26-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected, there being no allowable generic or linking claim. Applicant's election of group I, claims 1-25 and 32-43 1 in the reply filed on 03/15/2006 is acknowledged. Election was made **without** traverse in the reply filed on 03/15/2006.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-8, 11, 13-21 and 32-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Franklin et al. (Franklin), US Patent No. 5,852,436.

5. As to independent claims 1 and 13, Franklin discloses a method in a computer having a graphical user interface, comprising steps of:

creating an electronic sticky note having content (col. 6, lines 7-17: a note object (sticky note) is created, and text or other information is filled in the contents of the note object); and

attaching the electronic sticky note to a first item such that at least a portion of the content of the electronic sticky note is viewable without opening the first item (col. 1, lines 33-45 and col. 7, line 57 – col. 8, line 6 and Fig. 10: the note object is associated or attached with window/icon; Fig. 10 shows portions of notes such as “Note from Joe Bella”, “Vacation Reminder”, “Note 1”, etc... without opening the node that is associated with icon).

6. As to dependent claim 2, Franklin discloses steps of detaching the electronic sticky note from the first item (col. 1, lines 33-45); and

attaching the electronic sticky note to a second item different from the first item (col. 1, lines 33-45).

7. As to dependent claim 3, Franklin discloses a step of embedding the electronic sticky note in the first item (col. 1, lines 33-54).

8. As to dependent claim 4, Franklin discloses steps of detaching the electronic sticky note from the first item (col. 1, lines 33-54 and col. 6, lines 37-54); and

embedding the electronic sticky note in a second item different from the first item (col. 1, lines 33-54 and col. 6, lines 37-54).

9. As to dependent claim 5, Franklin discloses a step of displaying an icon representing the first item, wherein the icon includes an indication of whether the electronic sticky note is attached to the first item (col. 1, lines 33-54).

10. As to dependent claim 6, Franklin discloses steps of displaying an icon representing the first item (Fig. 4A); and

displaying an indication associated with the icon of whether the electronic sticky note is attached to the first item (Fig. 4A).

11. As to dependent claim 7, Franklin discloses wherein the step of displaying the indication includes displaying the indication so as to overlay the icon (Fig. 4B and col. 6, lines 18-29).

12. As to dependent claim 8, Franklin discloses wherein the indication includes at least a portion of the content of the electronic sticky note (col. 1, lines 33-45 and col. 7, line 57 – col. 8, line 6 and Fig. 10).

13. As to dependent claim 11, Franklin discloses a step of open the electronic sticky note without opening the first item (col. 1, lines 33-45 and col. 7, line 57 – col. 8, line 6 and Fig. 10).

14. As to independent claims 14 and 17, Franklin discloses a method in a computer having a graphical user interface, comprising a step of displaying an electronic sticky note having a user-selectable portion (col. 4, line 66 – col. 5, line 45); and

attaching the electronic sticky note to an underlying item icon in response to the user-selectable portion being selected (col. 4, line 66 – col. 5, line 45).

15. As to dependent claim 15, Franklin discloses a step of detaching the electronic sticky note for the item icon to which it is attached in response to the user-selectable portion being selected (col. 6, line 55 – col. 7, line 26).

16. As to dependent claim 16, Franklin discloses a step of visually indicating that the item icon has an attached electronic sticky note (Figs. 7&8).

17. As to independent claims 18 and 21, Franklin discloses a method in a computer having a graphical user interface, comprising a step of displaying an item icon and an indication that an electronic sticky note is attached to the item (col. 1, lines 33-45 and col. 7, line 57 – col. 8, line 6 and Fig. 10).

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18. As to dependent claim 19, Franklin discloses wherein the step of displaying includes displaying the indication so as to overlay the item icon (Figs. 7&8).

19. As to dependent claim 20, Franklin discloses wherein the indication is part of the item icon (col. 1, lines 33-45 and col. 7, line 57 – col. 8, line 6 and Figs. 7-10).

20. As to independent claim 32, Franklin discloses a method in a computer having a graphical user interface, comprising steps of:

adding content to an electronic sticky note (col. 6, lines 7-17: a note object (sticky note) is created, and text or other information is filled in the contents of the note object);
and

after the step of adding, attaching the electronic sticky note to a first item (col. 1, lines 33-45 and col. 7, line 57 – col. 8, line 6 and Fig. 10: the note object is associated or attached with window/icon).

21. As to dependent claim 33, Franklin discloses a step of detaching the electronic sticky note from the first item (col. 1, lines 33-45).

22. As to dependent claim 34, Franklin discloses a step of either attaching or embedding the sticky note to or in a second item different from the first item Franklin discloses.

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23. As to independent claim 35, Franklin discloses a method in a computer having a graphical user interface, comprising steps of:

adding content to an electronic sticky note (col. 6, lines 7-17: a note object (sticky note) is created, and text or other information is filled in the contents of the note object);
and

after the step of adding, embedding the electronic sticky note to a first item (col. 1, lines 33-45 and col. 7, line 57 – col. 8, line 6 and Fig. 10: the note object is associated or attached with window/icon).

24. As to dependent claim 36, Franklin discloses a step of detaching the electronic sticky note from the first item (col. 1, lines 33-45).

25. As to dependent claim 37, Franklin discloses a step of either attaching or embedding the electronic sticky note in or to a second item different from the first item (col. 1, lines 33-45).

26. Claims 22-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Kasriel, US Patent Application Publication No. 2003/0204490.

27. As to independent claims 22 and 25, Kasriel discloses a method in a computer having a graphical user interface, comprising steps of:

browsing to a remotely-generated Internet web page (Abstract: accessing web pages); and

attaching an electronic sticky note to the Internet web page (Abstract and page 2, paragraphs [0018]-[0019]: an annotation may be associated with a particular location or a particular object within the web page).

28. As to dependent claim 23, Kasriel discloses a step of generating and storing locally at the computer associating information associating the electronic sticky note with the Internet web page (page 2, paragraphs [0018]-[0019]).

29. As to dependent claim 24, Kasriel discloses a step of displaying at least a portion of the Internet web page and a visual indication of the electronic sticky note simultaneously, the visual indication of the electronic sticky note being displayed at a location on the Internet web page in accordance with the associating information (Fig. 2, and pages 3-4, paragraphs [0031]-[0033]).

30. Claims 38-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Otala et al. (Otala), US Patent Application Publication No. US 2004/0223747.

31. As to independent claim 38, Otala discloses a method in a computer, comprising steps of:

receiving a first photo file (Abstract: downloading photos);

receiving an audio file include audio data and adding the audio data to an electronic sticky note (Abstract and page 7, claim 10: audio annotation extracted from a connected source, thus the step of adding audio data to annotation must be inherent from audio annotation that already exists from the connected source).

32. As to dependent claim 39, Otala discloses a step of attaching the electronic sticky note to the first photo file (Abstract).

33. As to dependent claim 40, Otala discloses a step of embedding the electronic sticky note in the first photo file (Abstract).

Claim Rejections - 35 USC § 103

34. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin as applied to claims 1-8, 11, 13-21 and 32-37 above, and further in view of Jakobson, US Patent No. 6,697,838.

36. As to dependent claim 9, however Franklin does not explicitly disclose wherein the indication further indicates a type of the content of the electronic sticky note. Jakobson discloses creating a note file (electronic sticky note) that associated with a web site displaying in the web browser window by using voice recognition, keyboard or hand-written character, and when click on the button 134a to save the note file, the note file will be named with extension ".rff" to indicate the note file is saved in a rich text format (col. 6, line 56 – col. 7, line 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Jakobson and Franklin to include the indication further indicates a type of the content of the electronic sticky note so it would show what type of the note is saved.

37. As to dependent claim 10, Franklin and Jakobson disclose a step of displaying the content of the electronic sticky note in response to hovering over the first item (Jakobson, Fig. 2K).

38. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin as applied to claims 1-8, 11, 13-21 and 32-37 above, and further in view of Otala et al. (Otala), US Patent Application Publication No. US 2004/0223747.

39. As to dependent claim 12, Franklin however does not explicitly disclose wherein the content of the electronic sticky note includes audio content. Otala discloses audio annotation (electronic sticky note) associated with a downloaded photo (Abstract). It

would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Ojala and Franklin to include the content of the electronic sticky note includes audio content in order to provide a user the ability to create an enhanced photo digital video disc that carries additional information about the slide show material that is useful to a DVR.

40. Claims 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ojala et al. (Ojala), US Patent Application Publication No. US 2004/0223747.

41. As to dependent claim 41, even though Ojala does not explicitly disclose replicating the first photo file to create a second photo file, however, Examiner takes Official Notice that the use of copying, replicating or duplicating an image/picture/photo in computer system as conventional and well-known in the art. It would have been obvious at the time the invention was made to one of ordinary skill in the art to employ replicating the first photo file to create a second photo file since Examiner takes Official Notice that the use of copying, replicating or duplicating an image/picture/photo in computer system as conventional and well-known in the art.

attaching the electronic sticky note to the second photo file (Abstract).

42. As to dependent claim 42, even though Ojala does not explicitly disclose replicating the first photo file to create a second photo file, however, Examiner takes Official Notice that the use of copying, replicating or duplicating an image/picture/photo

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in computer system as conventional and well-known in the art. It would have been obvious at the time the invention was made to one of ordinary skill in the art to employ replicating the first photo file to create a second photo file since Examiner takes Official Notice that the use of copying, replicating or duplicating an image/picture/photo in computer system as conventional and well-known in the art.

embedding the electronic sticky note to the second photo file.

43. Claim 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otala et al. (Otala), US Patent Application Publication No. US 2004/0223747 as applied to claims 38-42 above, and further in view of Balabanovic, US Patent No. 6,624,826.

44. As to claim 43, Otala discloses limitations as discussed in claims 38-42 above. However, Otala does not explicitly disclose wherein the audio file includes a reference to the first photo file. Balabanovic discloses audio narrative that includes narration thread and one or more references to various types of electronic document, and the electronic document can be an image (photo) or web page (col. 8, line 16 – col. 9, line 6). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Balabanovic and Otala to include the audio file includes a reference to the first photo file in order to create a simple and effective visual representations for audio documents.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (571) 272-4092. The Examiner can normally be reached on Monday-Friday from 8:30 am to 5:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. On July 15, 2005, the Central Facsimile (FAX) Number will change from 703-872-9306 to 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chau Nguyen
Patent Examiner
Art Unit 2176

William F. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
5/1/2006